



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,345	12/01/2003	Stig Bakke	MRKS/0130	1281

7590 01/17/2006

WILLIAM B. PATTERSON
MOSER, PATTERSON & SHERIDAN, L.L.P.
Suite 1500
3040 Post Oak Blvd.
Houston, TX 77056

EXAMINER

COLLINS, GIOVANNA M

ART UNIT PAPER NUMBER

3672

DATE MAILED: 01/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,345

Applicant(s)

BAKKE, STIG

Examiner

Giovanna M. Collins

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6,7,9-12,14 and 15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6,7,9-12,14 and 15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The indicated allowability of claims 9, 14 and 15 is withdrawn in view of the newly discovered reference(s) to Bohnes '873, Kampf-Emden '675, Lancaster '430 and Head '969. Rejections based on the newly cited reference(s) follow.

Claim Objections

Claim 1 is rejected because this claim recites the limitation "the cutting tool" in line 15. There is insufficient antecedent basis for this limitation in the claim as this limitation has not been previously recited.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-2,6,7 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over MacDougall '565 in view of Jennings ' 526.

MacDougall discloses an apparatus for orientating a work tool, the apparatus comprising an a first anchor (15), an energy unit (for moving the motors), a programmable controller (col. 4, lines 36-40), an axial displacement part (piston rod at 16) and a rotational part (at 18) and a second anchor (15) wherein the axial displacement part (piston rod of element 16) is located between the first anchor and the

Art Unit: 3672

second anchor and at least one of the axial displacement part and the rotational part controllable by the programmable controller so that the work tool can be steered along any path within a work area. MacDougall does disclose a drilling bit (19) not disclose a high pressure water cutting. Jennings teaches a high pressure water cutter is a art recognized equivalent cutting element (col. 11, lines 33-419. Inasmuch as the references disclose these elements as art recognized equivalents, it would have been obvious to one of ordinary skill in the exercise art to substitute one for the other. In re Fout, 675 F.2d 297, 301, 213 USPQ 532, 536 (CCPA 1982). Therefore it would be obvious to one of ordinary skill in the art at the time of the invention to modify the apparatus disclosed by MacDougall to have a high pressure water cutter in view of teaches of Jennings because it would have been obvious to one of ordinary skill in the exercise art to substitute one art recognized equivalent for the other.

Referring to claim 2, MacDougall discloses the axial displacement part (at 16) is telescopic.

Referring to claims 6-7, MacDougall discloses wherein the work tool (at 19) is a cutting tool and is operatively connected to the rotational part (at 18).

Referring to claim 10, MacDougall discloses the axial displacement part comprises a piston rod (at 16).

Referring to claim 11, MacDougall discloses the rotational part (at 18) is coupled to the second anchor (at 15).

Referring to claim 12, MacDougall discloses the rotational part (at 18) is coupled to the telescopic member.

2. Claims 1-2,6,7 and 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bohnes 4,185,873 .

Bohnes discloses an apparatus for orientating a work tool, the apparatus comprising an a first anchor (6), an energy unit (hydraulic motors, see col. 7, lines 14-19), a programmable controller (col. 4, lines 52-55), an axial displacement part (piston rods in cylinder 8) and a rotational part (at 3') and a second anchor (7) wherein the axial displacement part (at 8) is located between the first anchor and the second anchor, and a high pressure water cutter (water jets, see col. 5, lines 20-25 and col. 10, lines 42-45) Bohnes does not specifically disclose the controller controls the axial or rotational part. However, Bohnes does disclose the axial part (at 8) is a piston cylinder arrangement and the control device can control piston cylinder arrangement. As it would be advantageous to be able to control the axial part from a remote location it would be obvious to one of ordinary skill in the art to modify the apparatus disclosed by Bohnes to control the axial part with the controller.

Referring to claim 2, Bohnes discloses the axial displacement part (piston rod of 8) is telescopic.

Referring to claims 6-7, Bohnes discloses wherein a work tool (at 3) is a cutting tool and is operatively connected to the rotational part (at 3').

Referring to claim 10, Bohnes discloses the axial displacement part comprises a piston rod (at 8).

Art Unit: 3672

Referring to claim 11, Bohnes discloses the rotational part (at 3') is coupled to the second anchor (at 6 through body 5).

Referring to claim 12, Bohnes discloses the rotational part (at 3') is coupled to the telescopic member (at 8 through body 5).

3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over MacDougall '565 in view of Jennings ' 526 as applied to claim 2 and further in view of Lancaster 4,470,430.

MacDougall does not disclose the position of the telescopic member is transmitter by a position transmitter transmits. Lancaster teaches a position transmitter is a well known means to measure the position of a rotational part (col. 5, lines 45-51). As one of ordinary skill would be familiar with an position transmitter, it would be obvious to one of ordinary skill in the to modify the apparatus disclosed by MacDougall, as modified by Jennings, to transmit the relative position using an position transmitter in view of the teachings of Lancaster.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over MacDougall '565 in view of Jennings ' 526 as applied to claim 1 and further in view of Head 2002007969.

MacDougall does not disclose the position of the rotational member is transmitted by a angle transmitter. Lancaster teaches a angle transmitter is a well known means to measure the position of a rotational part (paragraph 0051). As one of

Art Unit: 3672

ordinary skill would be familiar with an angle transmitter, it would be obvious to one of ordinary skill in the art to modify the apparatus disclosed by MacDougall, as modified by Jennings, to transmit the relative position using an angular transmitter in view of the teachings of Head.

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kampf-Emden 3,498,675 in view of Bohnes 4,185,873 .

Kampf-Emden discloses a method of orientating a work tool in a wellbore, directing the work tool (2) with an axial displacement part (14a) and a rotational part (col. 4, lines 17-18) operable connected to at least one of a first and second anchor (5,9) wherein the axial displacement part (14a) is positioned between the first anchor and the second anchor, and releasing the first anchor moving the first anchor to a new position in the wellbore; setting the first anchor at the new position and releasing the second anchor (col. 1, lines 35-55). Kampf-Emden discloses the axial part is a piston cylinder arrangement but does not disclose a controller controls the axial or rotational part. Bohnes teaches using a programmable controller to control a piston cylinder arrangement. As it would be advantageous to be able to control the axial part from a remote location it would be obvious to one of ordinary skill in the art to modify the apparatus disclosed by Kampf-Emden to control the axial part with the controller in view of the teachings of Bohnes.

Art Unit: 3672

6. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over MacDougall '565 in view of Lancaster 4,470,430.

MacDougall discloses an apparatus for orientating a work tool, the apparatus comprising an a first anchor (15), an energy unit (for moving the motors), a programmable controller (col. 4, lines 36-40), an axial displacement part (piston rod at 16) and a rotational part (at 18) and a second anchor (15) wherein the axial displacement part (piston rod of element 16) is located between the first anchor and the second anchor and at least one of the axial displacement part and the rotational part controllable by the programmable controller so that the work tool can be steered along any path within a work area. MacDougall does not disclose the position of the telescopic member is transmitter by a position transmitter transmits. Lancaster teaches a position transmitter is a well known means to measure the position of a rotational part (col. 5, lines 45-51). As one of ordinary skill would be familiar with an position transmitter, it would be obvious to one of ordinary skill in the to modify the apparatus disclosed by MacDougall to transmit the relative position using an position transmitter in view of the teachings of Lancaster.

7. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over MacDougall '565 in view of Head 2002007969.

MacDougall discloses an apparatus for orientating a work tool, the apparatus comprising an a first anchor (15), an energy unit (for moving the motors), a programmable controller (col. 4, lines 36-40), an axial displacement part (piston rod at

Art Unit: 3672

16) and a rotational part (at 18) and a second anchor (15) wherein the axial displacement part (piston rod of element 16) is located between the first anchor and the second anchor and at least one of the axial displacement part and the rotational part controllable by the programmable controller so that the work tool can be steered along any path within a work area. MacDougall does not disclose the position of the rotational member is transmitted by a angle transmitter. Lancaster teaches a angle transmitter is a well known means to measure the position of a rotational part (paragraph 0051). As one of ordinary skill would be familiar with an angle transmitter, it would be obvious to one of ordinary skill in the to modify the apparatus disclosed by MacDougall to transmit the relative position using an angular transmitter in view of the teachings of Head.

Response to Arguments

8. Applicant's arguments with respect to claims 1-4,6,7,9-12,14 and 15 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna M. Collins whose telephone number is 571-272-7027. The examiner can normally be reached on 6:30-3 M-F.

Art Unit: 3672

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


gmc


David Bagnell
Supervisory Patent Examiner
Technology Center 3670